

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

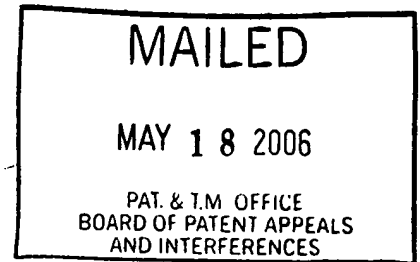
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Ex parte GILBERT WOLRICH, DEBRA BERNSTEIN, MATTHEW J. ADILETTA  
and DONALD F. HOOPER

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Application 09/475,614

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on March 30, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

Two Information Disclosure Statements (IDSs) were filed on October 18, 2004 and October 20, 2004. It is not clear from the record whether the examiner considered the IDSs or whether the examiner notified appellant of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

A review of the file indicates that on July 25, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on July 25, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) **Evidence appendix.** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) **Related proceedings appendix.** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

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An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed July 25, 2005:

1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and

2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Also, a review of the file indicates that the Appeal Brief fee has not been charged to the Deposit Account No. 06-1050. The Appeal Brief fee needs to be charged to the Deposit Account.

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The Examiner's Answer mailed September 16, 2005 is not in compliance with the requirements of 37 CFR § 41.37. The following heading need to be included in accordance with MPEP 1207.02:

"Related Proceeding Appendix" - Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the "Related Appeals and Interferences" section of the answer.

A revised Examiner's Answer that is in compliance with 37 CFR § 41.37 is required.

Accordingly, it is

ORDERED that the application is return to the Examiner to:

- 1) consider the Information Disclosure Statements filed October 18, 2004 and October 20, 2004;
- 2) provide appropriate written notification by the examiner to appellants of such consideration;
- 3) hold the Appeal Brief filed on July 25, 2005, defective;
- 4) notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37 or for the examiner to present a statement regarding the position taken on the missing appendices;
- 5) to have Appeal Brief fee changed to Deposit Account;

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- 6) to vacate the Examiner's Answer mailed September 16, 2005, and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and
- 7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCE

A handwritten signature in black ink, appearing to read 'D. M. Shaw', with a long horizontal flourish extending to the right.

DALE M. SHAW  
Deputy Chief Appeal Administrator  
(571) 272-9797

DMS/pgc

cc: Fish & Richardson PC  
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